

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-7 are pending in the application, with claim 1 being the only independent claim.

Applicants believe no new matter is added by these amendments. Support for these amendments can be found in the specification as filed.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Restriction under 35 U.S.C. § 121 and 372

The Examiner has required an election of one invention to prosecute, under 35 U.S.C. § 121 and 372, in the above-referenced patent application. Applicants hereby affirm their original reply to provisionally elect to prosecute the invention of Group II represented by claims 1-7. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse.

Applicants reiterate that this application is a National Phase Entry Under 35 U.S.C. § 371 and, as such, PCT Rule 13 requiring unity of invention applies. Title 37 of the Code of Federal Regulations states:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories: . . .

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; . . .

37 C.F.R. § 1.475(b)(3).

The following example is also provided in Chapter 10 of the International Search and Preliminary Examination Guidelines:

- Claim 1: A method of manufacturing chemical substance X.
Claim 2: Substance X.
Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

paragraph 10.21, Example 1.

Elected Group II contains claims drawn to specific compounds containing a pyrazole ring. Group X is drawn to a process of making the compounds of Group II. Groups XI and XII are drawn to methods of using the compounds of Group II. Groups II, X, XI and XII therefore share unity of invention because the special technical feature common to all the claims in the groups is the compounds of Group II. Groups II, X-XII should therefore be examined together.

Further, the inventions of Group II and Group VIII should be examined together because both groups are drawn to the same silylated carboxamide structure wherein the radical A is a substituted pyrazole. Applicants respectfully request that Groups II and VIII be examined together.

Even if the restriction between Groups II and VIII, and Groups X-XII were proper, Groups X-XII should be rejoined once the Examiner finds that Groups II and VIII are allowable. Under MPEP §821.04, where elected claims are found allowable, withdrawn claims that require all the limitations of an allowable claim will be rejoined and fully examined for patentability. Rejoinder of Groups II and VIII, and Groups X-XII is respectfully requested.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 101

The rejection of claim 5 under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite and under 35 U.S.C. § 101 as allegedly improperly defined, is respectfully traversed. (Office Action, page 7, line 20, through page 8, line 14).

Claim 5, as amended, recites a method of controlling unwanted microorganisms comprising applying the composition of claim 4. Accordingly, Applicants argue that claim 5 as amended is definite and properly defined. Applicants request withdrawal of the rejection.

Rejection under 35 U.S.C. § 103(a)

The rejection of claims 1, 2 and 4 under 35 U.S.C. § 103(a) as allegedly being obvious over Ehrenfreund *et al.*, WO 03/080628 ("Ehrenfreund") in view of Silverman R.B. "Drug Development: Lead Modification," in *The Organic Chemistry of Drug Design and Drug Action*, Silverman R.B., ed., Academic Press, San Diego, pp. 15-22 ("Silverman") is respectfully traversed.

Claims 1 and 2, as amended, do not recite the dichloromethyl substituent in the definition of R₁₂. Furthermore, Applicants argue that substituting an iodine or chlorine substituent in place of the difluoromethyl group of Ehrenfreund would not have been *prima facie* obvious because, *inter alia*, a person of ordinary skill in the art would not have expected that such compounds would be useful as fungicides given the unpredictability in this art.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Cynthia M. Bouchez
Attorney for Applicants
Registration No. 47,438

Date: May 2, 2008

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

812454_2.DOC